

suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references or to modify the reference teachings. See Manual of Patent Examining Procedure (MPEP), Eighth Edition, August 2001, §706.02(j).

Applicant submits that the Examiner has failed to establish a proper *prima facie* case of obviousness in the present §103(a) rejection, in that the Sakamoto and Ramchandran references, even if assumed to be combinable, fail to teach or suggest all the limitations of each of independent claims 1, 15, 29, 31, 33-35 and 37, and in that no cogent motivation has been identified for combining the references or for modifying the reference teachings to reach the claimed invention. Furthermore, even if it is assumed that a *prima facie* case has been established, there are teachings in one or more of the references that controvert the obviousness arguments of the Examiner.

The present invention as set forth in independent claims 1, 15, 29, 31, 33-35 and 37 is generally directed to arrangements in which information is delivered in a partially-encrypted format using multiple bitstreams of a digital communication system. Each of these claims specifies that the multiple bitstreams are transmitted in subbands of one or more digital sidebands of a carrier signal in the system.

For example, with reference to claim 1, at least a portion of the information is delivered to a receiver in an at least partially-encrypted format using the multiple bitstreams transmitted in subbands of one or more digital sidebands of a carrier of a digital communication system, such that access to the information is provided at a first quality level. Upon decryption of the at least partially-encrypted format, access to the information is provided at another quality level.

This exemplary partially-encrypted format advantageously allows access to the information to be provided, for instance, at a first quality level without decrypting the second bitstream. If the second bitstream is decrypted, access to the information may be provided at a second quality level higher than the first.

The Examiner acknowledges that Sakamoto fails to meet these claim limitations, but argues that the combined teachings of Sakamoto and Ramchandran meet the limitations in question. Applicant respectfully disagrees. The collective teachings of these references simply fail to teach or suggest the claimed arrangements. For example, the Examiner argues that the claim limitations relating to multiple bitstreams being transmitted in subbands of one or more digital sidebands of a

carrier signal in the system are shown in the teachings in FIG. 14 and column 15, lines 20-40, of Ramchandran. However, in the relied-upon portion of Ramchandran, subchannel 1 and subchannel 2 are not subbands of one or more digital sidebands of a carrier signal as claimed. Instead, subchannel 1 and subchannel 2 each characterize a designated portion of the frequency spectrum corresponding to an output of a particular QAM transmitter, as shown in FIG. 14. Even if one were to assume, for purposes of argument only, that subchannel 1 and subchannel 2 constitute a pair of digital sidebands of the “interfering carrier” shown in FIG. 14, there is no teaching or suggestion whatsoever in Ramchandran regarding multiple bitstreams being transmitted in subbands of such digital sidebands, as would be required by the claim limitations at issue. There is apparently no discussion at all in Ramchandran regarding subbands of the subchannel 1 and subchannel 2 portions of FIG. 14.

The proposed combination of Sakamoto and Ramchandran thus fails to teach or suggest all of the limitations of independent claim 1.

The collective teachings of the cited references are similarly deficient with regard to the other independent claims.

With regard to motivation, the proposed combination of Sakamoto and Ramchandran appears to be based on a piecemeal reconstruction of the claimed invention, with the benefit of hindsight, rather than on any objective evidence in the references themselves.

More specifically, the Examiner in the final Office Action states as follows regarding motivation to combine Sakamoto and Ramchandran, with emphasis supplied:

At the time the invention was made, it would have been obvious . . . to modify the teachings of Sakamoto such that multiple bitstreams are transmitted in subbands of one or more digital sidebands of a carrier signal in the system. One of ordinary skill in the art would have been motivated to do this because it would provide a system that is able to broadcast signals representing the same data at different resolutions (Sakamoto: col. 4, lines 45-60).

The Federal Circuit has stated that when patentability turns on the question of obviousness, the obviousness determination “must be based on objective evidence of record” and that “this precedent

has been reinforced in myriad decisions, and cannot be dispensed with.” In re Sang-Su Lee, 277 F.3d 1338, 1343 (Fed. Cir. 2002). Moreover, the Federal Circuit has stated that “conclusory statements” by an examiner fail to adequately address the factual question of motivation, which is material to patentability and cannot be resolved “on subjective belief and unknown authority.” Id. at 1343-1344. There has been no showing in the present §103(a) rejection of objective evidence of record that would motivate one skilled in the art to combine Sakamoto and Ramchandran, or to modify their teachings to reach the particular limitations in question. The statement of obviousness given by the Examiner in the final Office Action is precisely the type of subjective, conclusory statement that the Federal Circuit has indicated provides insufficient support for an obviousness rejection.

The portion of the Sakamoto reference relied upon by the Examiner in support of his motivation statement is column 4, lines 45-60, which provides as follows:

By further providing storage means on the reception apparatus side, the received synthesized data can be recorded or edited. Use of the storage means enables data exchange with only the privileged viewers.

A digital television broadcasting system of the present invention is a system that converts digital television signals into a plurality of encoded signals differing in resolution, layers these signals, and broadcasts them, and is characterized by comprising: scrambling means that is provided on the transmission side and performs a scrambling process on only the high layer ones of the plurality of encoded signals; and descrambling means that is provided on the reception side and performs a descrambling process on the encoded signals subjected to the high layer scrambling process, wherein for the high layer encoded signals, the output of the descrambling means undergoes a decoding process, whereas for the low layer encoded signals, the decoding process is performed without the descrambling process.

It is difficult to see how this relied-upon portion of Sakamoto provides any objective evidence whatsoever of motivation to combine Sakamoto with Ramchandran. Instead, it is more properly viewed as a teaching away from the proposed combination, since it teaches to utilize a scrambling

and descrambling approach to differentiate high layer encoded signals from low layer encoded signals.

Thus, even if it is assumed that a proper *prima facie* case has been established, there are particular teachings in one or more of the references which controvert the obviousness argument put forth by the Examiner. As noted above, the column 4, lines 45-60, portion of Sakamoto relied upon by the Examiner constitutes such a teaching away from the proposed combination in that the scrambling and descrambling described therein is not readily combinable, or even workable, in the Ramchandran system.

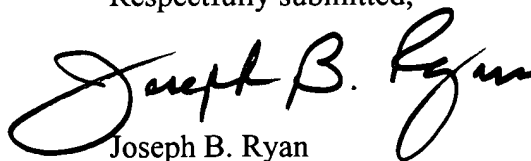
Independent claims 1, 15, 29, 31, 33-35 and 37 are therefore believed to be allowable over the proposed combination of Sakamoto and Ramchandran.

Dependent claims 2-14, 16-28, 30, 32, 36 and 38 are believed allowable for at least the reasons identified above with regard to their respective independent claims. The Saito reference fails to overcome the fundamental deficiencies of Sakamoto and Ramchandran as applied to the independent claims. In addition, the dependent claims are believed to define additional separately-patentable subject matter relative to the proposed combination of references.

In view of the above, Applicant believes that claims 1-38 are in condition for allowance, and respectfully requests withdrawal of the §103(a) rejections.

As indicated previously, a Notice of Appeal is submitted concurrently herewith.

Respectfully submitted,

A handwritten signature in black ink, reading "Joseph B. Ryan". The signature is fluid and cursive, with the first name "Joseph" and last name "Ryan" clearly legible.

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Enclosure(s): Notice of Appeal